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EXAMINER

DESANTO, MATTHEW F

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UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte TING TINA YE, RHODA M. SANTOS,
ELAINE LIM, MAI XUAN TRAN,
HANH DOAN, and SIMON NGOC HUU NGUYEN

Appeal 2008-005974
Application 09/839,065
Technology Center 3700

Decided: June 12, 2009

Before TONI R. SCHEINER, LORA M. GREEN, and
JEFFREY N. FREDMAN, *Administrative Patent Judges*.

FREDMAN, *Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING

Appellants have requested rehearing of the decision entered April 1, 2009. That Decision affirmed the Examiner's rejections of claims 1 and 41 under 35 U.S.C. § 102(e) over Samson, of claims 1, 3-6, 8-11, 13-15, 17, and 18 under 35 U.S.C. § 103(a) over Samson and of claims 1, 3-34, and 41 under 35 U.S.C. § 103(a) over Samson and Nita. We have jurisdiction under 35 U.S.C. § 6(b).

Issue

Did our use of the doctrine of inherency in the analysis of the rejections under 35 U.S.C. § 102(e) and 35 U.S.C. § 103(a) result in new grounds of rejection?

Findings of Fact

1. In the Final Rejection (2/25/03), the Examiner stated that “[a]s to the distal tip not being shapeable, the examiner interprets this, as meaning the distal tip of the catheter would be able to form a shape or have enough flexibility to maneuver the tip of the catheter through out the body. This is taught by Sampson ('099) in the entire reference because the catheter is designed to be used in the body to move through curved vessels (Column 5, lines 20-35), and therefore **would have to be shapeable** (Final Rej. 2/25/03 6, emphasis added).

2. In the Final Rejection (1/28/04), the Examiner states that “the examiner holds the limitation ‘shapeable by thermoforming techniques’ to be a product by process limitation” (Final Rej. 1/28/04 5).

3. In the Final Rejection (1/28/04), the Examiner also states that “[t]he examiner still believes that the catheter of Sampson will perform the same function of the applicant's claimed invention (wherein Sampson's catheter will be able to be shaped) and thus still read on the applicant's invention” (Final Rej. 1/28/04 6).

4. In the Advisory Action (11/4/04), the Examiner finds that
The examiner understands the definition of shape and understands the structure that is being claimed, according to MPEP section 2112.01, 2114, if the claimed invention and the prior art have the same structure then they would perform the same function. The examiner applies Samson,

since Samson has the same structural limitations and works in the same fashion. Samson has the ability to be flexible and maneuver through the circulatory system; it would be able to be shaped, since it would have to obtain different shapes when moving through the body. (See paper dated 02/25/03). According to the remarks made in paper dated 11/12/03 the applicant argues that the “tip can be shaped” and therefore the examiner interprets this as a functional language limitation, not an actual structure. According to MPEP section 2112.01, 2114, the examiner interprets that the prior art invention only needs to be capable of being shaped to anticipate the claim. This limitation is taught in Samson.

(Advisory Action (11/4/04).

5. In the Examiner’s Answer, the Examiner responds to Appellants’ citation of MPEP 2173.05(p)(I), finding that “[t]his section of the MPEP does not give any insight into how to interpret claims that have process limitations in an apparatus claim. Sections 2112.01, 2112.02, and 2113 of the MPEP are the areas that cover the interpretation of these claims” (Ans. 3-4).

6. In the Examiner’s Answer, the Examiner finds that “[t]he functional statement is ‘shapeable’, which the examiner used MPEP section 2112, and 2114 to find the scope of the claim” (Ans. 5).

7. MPEP § 2112 is titled “Requirements of Rejection Based on Inherency; Burden of Proof” and begins “[t]he express, implicit, and *inherent* disclosures of a prior art reference may be relied upon in the rejection of claims under 35 U.S.C. 102 or 103” (MPEP § 2112; emphasis added).

8. In the Examiner's Answer, the Examiner stated that the "examiner would also like to note that according to MPEP section 2112.01, 'Where the claimed and prior art products are identical or substantially identical in structure or composition, or are produced by identical or substantially identical processes, a prima facie case of either anticipation or obviousness has been established. In re Best, 562 F.2d 1252, 1255, 195 USPQ 430, 433 (CCPA 1977)' and therefore, a prima facie position has been established" (Ans. 5).

9. In the Reply Brief, Appellants state that "[t]he Examiner cites sections 2112.01 (Composition, Product and Apparatus Claims) as well as 2112.02 (Process Claims), both of which fall within MPEP 2112, which is the MPEP section for Inherency Rejections" (Reply Br. 5).

10. In the Reply Brief, Appellants also state regarding the citation of MPEP 2112 that "[e]ach of these sections were cited for the first time in the present prosecution in the Advisory Action dated November 4, 2004, , and repeated in the Examiner's Answer. Thus, it appears that the Examiner is now attempting to change the grounds of rejection by bringing into consideration the question of whether there is inherent disclosure in the cited references" (Reply Br. 5).

Principles of Law

A new ground of rejection occurs when the Examiner and the Board rejected a claim for different reasons. *In re Kumar*, 418 F.3d 1361, 1368 (Fed. Cir. 2005), citing *In re Waymouth*, 486 F.2d 1058, 1060-61 (CCPA 1973).

“[T]he ultimate criterion of whether a rejection is considered ‘new’ in a decision by the board is whether appellants have had fair opportunity to react to the thrust of the rejection.” *In re Kronig*, 539 F.2d 1300, 1302 (CCPA 1976).

Analysis

Appellants contend that “[n]ever in the course of prosecution does the Examiner claim that the ‘shapeable’ limitation is a material property of the recited device, and never does the Examiner assert the inherency of this limitation in Samson” (Req. Reh’g 3). Appellants contend that “[t]his is a substantially different basis for the rejections than product-by-process reasoning advanced by the Examiner. Significantly, Appellants never had an opportunity to respond to a rejection based on inherency because such a rejection was, prior to the Decision on Appeal, never applied” (Req. Reh’g 3).

However, the record reflects that the Examiner, in the first Final Rejection, noted that the catheter “would *have* to be shapeable” (Final Rej. 2/25/03; FF 1; emphasis added). While the Examiner also stated in the second Final Rejection that the limitation was a “product-by-process” limitation, that Final rejection also found that the “catheter of Sampson will perform the same function of the applicant's claimed invention” (Final Rej. 1/28/04 6; FF 2-3).

In the Advisory Action and the Examiner’s Answer, the Examiner clearly relied upon the inherency doctrine, repeatedly citing to sections of MPEP § 2112, which exclusively discusses the inherency doctrine (FF 4-8).

The Examiner also referred to the central inherency teaching in the court's decision in *Best* (FF 8).

Appellants were clearly placed on notice of this reliance on the inherency doctrine, as they referred to the inherency doctrine in the Reply Brief, noting that “[t]he Examiner cites sections 2112.01 (Composition, Product and Apparatus Claims) as well as 2112.02 (Process Claims), both of which fall within MPEP 2112, which is the MPEP section for Inherency Rejections” (Reply Br. 5; FF 9). In the Reply Brief, Appellants contend that prior to the advisory and Examiner's Answer, inherency was never raised and was a change in the grounds of rejection (FF 10). However, Appellants were clearly placed on notice of the reliance by the Examiner on the inherency doctrine at least by the Advisory Action, if not earlier (FF 1-8).

Appellants did not request that prosecution be reopened under 37 C.F.R. § 41.39(b)(1). In fact, Appellants filed a Reply Brief which specifically addressed this issue (FF 9-10).

Consequently, we find that Appellants were placed on notice by the Examiner, at least as of the Advisory Action, and had a fair opportunity to address the inherency issue in both their Appeal Brief and in their Reply Brief. *See In re Kronig*, 539 F.2d 1300, 1302 (CCPA 1976) (“[T]he ultimate criterion of whether a rejection is considered ‘new’ in a decision by the board is whether appellants have had fair opportunity to react to the thrust of the rejection.”)

Appellants' Request for Rehearing does not point to any argument, any evidence of record, or any legal authority, that was before us in the Briefs, that we overlooked or misapprehended in reaching the conclusions

set forth in the Decision. We therefore decline to revisit our earlier conclusions.

Conclusion of Law

Our use of the doctrine of inherency in the analysis of the rejections under 35 U.S.C. § 102(e) and 35 U.S.C. § 103(a) did not result in new grounds of rejection.

CONCLUSION

Appellant's request for rehearing is granted to the extent that we have reconsidered our earlier decision but denied in all other respects.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv)(2006).

DENIED

dm

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